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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------|-------------|----------------------|---------------------|------------------|
| 09/483,737 | 01/14/2000 | Hansjorg Reichert | GR-97-P-1903 | 8769 |
| 24131 | 7590 | 08/10/2007 | | |
| LERNER GREENBERG STEMER LLP | | | EXAMINER | |
| P O BOX 2480 | | | SEFER, AHMED N | |
| HOLLYWOOD, FL 33022-2480 | | | | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2826 | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 08/10/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/483,737

Applicant(s)

REICHERT ET AL.

Examiner

A. Sefer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,9,10 and 15 is/are pending in the application.
- 4a) Of the above claim(s) 1,9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/18/2007 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spaeth et al. ("Spaeth") USPN 5,943,553 in view of Komata et al. ("Komata") JP 2-15897 (of record).

Spaeth discloses in figs. 1 and 2 a semiconductor component comprising a solder 4 containing at least two components with at least two constituents including a first constituent containing a precious metal **Au** and a second constituent **Sn**; a substrate 3; a semiconductor chip (1, 2) having a rear side and an adhesive or diffusion barrier (col. 3, lines 52-58) provided on said rear side; said adhesive or diffusion barrier being provided directly on said solder; and said semiconductor chip being secured at said rear side to said substrate using said solder to form a chip-substrate connection by said solder and having a thickness within the range recited in the

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claim (col. 3, lines 49-51), but lacks anticipation of solder having a hypereutectic concentration of said second constituent.

Komata discloses a solder composition containing two components with two metal-containing constituents including a constituent formed of precious metal or gold and a second constituent or tin, and said solder composition having a hypereutectic concentration of the second constituent wherein said solder composition is Sn: 12-37 wt% and Au: balance. Note that the recitation calling for, "... weight of Au to Sn of initially 70 to 30" does not further restrict the device structure. See In re Hirao, 190 USPQ 15 at 17 (footnote 3). See also In re Brown, 173 USPQ 685 and In re Thorpe, 227 USPQ 964, 966.

Therefore, in view of Komata's teachings, a person skilled in the art would be motivated to provide a hypereutectic concentration of tin as disclosed by Komata. The motivation to do so is that the Au-Sn alloy solder exhibits good formability and good ductility as taught by Komata.

4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurokawa et al. ("Kurokawa") JP 63-136533 in view of Komata and Bacon et al. ("Bacon") USPN 5,234,153 (all of record).

Kurokawa discloses in figs. 1 and 2 a semiconductor component comprising a solder 4 containing at least two components with at least two constituents including a first constituent containing a precious metal **Au** and a second constituent **Sn**; a substrate 1; a semiconductor chip 3 having a rear side and an adhesive or diffusion barrier 9/10 provided on said rear side; said adhesive or diffusion barrier being provided directly on said solder; and said semiconductor chip being secured at said rear side to said substrate using said solder to form a chip-substrate

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connection by said solder, but lacks anticipation of solder having the recited thickness and a hypereutectic concentration of said second constituent.

Komata discloses a solder composition containing two components with two metal-containing constituents including a constituent formed of precious metal or gold and a second constituent or tin, and said solder composition having a hypereutectic concentration of the second constituent wherein said solder composition is Sn: 12-37 wt% and Au: balance. Note that the recitation calling for, "... weight of Au to Sn of initially 70 to 30" does not further restrict the device structure. See In re Hirao, 190 USPQ 15 at 17 (footnote 3). See also In re Brown, 173 USPQ 685 and In re Thorpe, 227 USPQ 964, 966.

Bacon teaches (see col. 1 lines 50-63 and claim 7) the advantage of using gold-tin compound solder having a thickness of less than 4 μm .

Therefore, in view of Komata's teachings, a person skilled in the art would be motivated to provide a hypereutectic concentration of tin as disclosed by Komata. The motivation to do so is that the Au-Sn alloy solder exhibits good formability and good ductility as taught by Komata. It would have been obvious to employ a solder having a thickness of 1 μm to 2 μm since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or working ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. The motivation to do so is to provide a better thermal conductance.

Note that although Komata teaches brazing, it is to be noted that the recitation, "being consumed during soldering operation by one reacting and being dissolved ..." does not distinguish over Komata regardless of the method used to form the solder since claims are directed to the product per se, no matter how actually made, In re Hirao, 190 USPQ 15 at 17

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(footnote 3). See also *In re Brown*, 173 USPQ 685 and *In re Thorpe*, 227 USPQ 964, 966.

Furthermore, the functional language, "Sn contained ... providing a continuous reduction in melting temperature during a soldering procedure" is directed to the device per se, no matter which of the device's functions is referred to in the claim. See *In re Ludtke and Sloan*, 169 USPQ 563 at 567, and *In re Swinehart*, 169 USPQ 226, both of which make it clear that it is the patentability of the device per se which must be determined in a "functional language" claim and not the patentability of the function, and that an old or obvious device alleged to perform a new function is not patentable as a device, whether claimed in "functional language" terms or not.

Note that the above case law makes it clear that in such cases applicant has the burden of showing that a prior art device that appears reasonably capable of performing the allegedly novel function is in fact incapable of doing so. See MPEP § 2114. See *In re Schreiber*, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997) (Spout having "taper ... such as to by itself jam up the popped popcorn before the end of the cone and permit the dispensing of only a few kernels at a shake" anticipated by an oil can spout having the same shape as spout Applicant disclosed as being adapted for dispensing said only a few kernels at said shake) for a discussion of the roles of examiner and applicant in determining when and how functional limitations distinguish a claim from prior art disclosing the same structure. See also *In re King*, 231 USPQ 136 (Fed. Cir, 1986) ("It did not suffice merely to assert that Komata does not inherently achieve hypereutectic concentration, challenging the PTO to prove the contrary by experiment or otherwise. The PTO is not equipped to perform such tasks.")


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Sefer whose telephone number is (571) 272-1921.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sue Purvis can be reached on (571) 272-1236.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ANS
August 6, 2007


A. Sefer
Patent Examiner
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